

REMARKS

Claims 1-96 are pending in the present application. Claims 1, 2, 7, 8, 12, 13, 15, 16, 18, 21, 24-26, 30, 31, 32, 36, 37, 39-42, 45, 48, 49, 56, 60, 61, 63, 64, 66, 69, 72-74, 78-80, 84, 87, 88, 90, 93, 95 and 96 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101

The Examiner rejected Claims 73-96 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter for failing to define a concrete, useful and tangible result. This rejection is respectfully traversed.

Effective March 29, 1996, the PTO amended the detailed Manual of Patent Examining Procedure ("MPEP") to include section 2106, commonly known as the Examination Guidelines for Computer-Related Inventions. A claimed computer-readable medium encoded with a computer program defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al. Indeed, a November 2003 search of the PTO database reveals that the phrase "computer-readable medium" appears in the claims of over 5,500 issued U.S. patents. Per the present invention of Claims 73-92, the useful, concrete and tangible result is a catalog. Claims 73-92 have also been amended to expressly recite an article of manufacture, which is particularly identified as being statutory in 35 U.S.C. 101. Thus, the requirements of 35 U.S.C. 101 have been met.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-72 under 35 U.S.C. § 103(a) as being unpatentable over Barnes (U.S. Patent No. 5,970,475) (hereinafter "Barnes") in view over Heckerman et al. (U.S. Patent No. 6,633,852) (hereinafter "Heckerman"). This rejection is respectfully traversed.

Generally speaking, the present invention is directed to a technique for establishing a customized catalog. The teachings of the cited reference assume the existence of a pre-existing catalog that is used for generating purchase orders.

Specifically with respect to Claim 1, none of the cited references teach or suggest the claimed steps of “placing items in a meta-shopping cart in response to a selection of the items by a user”, “generating the customized catalog using items in the meta-shopping cart in response to a request to generate the customized catalog”, and “placing the customized catalog on a Web site”. As can be seen, Claim 1 is specifically directed to a technique for generating a customized catalog that is placed on a web site. In rejecting Claim 1, the Examiner recites numerous teachings by both Barnes and Heckerman, including a supplier catalog server (Barnes Figure 1, element 42) and selecting products for a list (Barnes Figure 11, element 132). Notably absent is any assertion by the Examiner that any of the cited references teach or suggest a method for generating a customized catalog that is placed on a web site. This is likely because neither reference teaches or suggests such claimed features. Because of this failure by the Examiner to properly establish a *prima facie* showing of obviousness, it is urged that (i) the burden has not yet shifted to Applicants to rebut an obviousness assertion¹, and (ii) Claim 1 has thus been erroneously rejected².

Barnes teaches that a user selects items for purchase from a preexisting catalog. While a template may be used for displaying catalog information in a form specified by a customer, the specifics of how such template is created or specified is not described. Barnes merely states that “by evaluating the buyer’s profile, the Supplier Catalog Server 42 can custom display catalog information and pricing specific to the buyer or the buyer’s organization” (column 19, lines 54-59). There is no indication that this template or a

¹ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

² If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

resulting catalog is generated by the specific claimed steps of “placing items in a meta-shopping cart in response to a selection of the items by a user”, “generating the customized catalog using items in the meta-shopping cart in response to a request to generate the customized catalog”, and “placing the customized catalog on a Web site”. In any event, in order to expeditiously move this case to issuance, Applicants have amended Claim 1 to include the features originally recited in Claim 2. It is further urged that none of the cited references teach or suggest the claimed feature of “allowing purchases from the customized catalog on the Web site by a selected buyer”. This claimed feature further highlights the advantages of the claimed invention, where the customized catalog placed on the Web site can then be used for purchases. The cited Barnes reference teaches that a buyer places a conventional purchase order from items selected from a pre-existing catalog (col. 22, lines 46-53; Figure 11), and sends this purchase order to the supplier using an EDI message (col. 20, lines 55-67). There is no teaching or suggestion of placing a catalog that has been customized onto a web site for subsequent use in allowing purchases from such customized catalog. Thus, Claim 1 is further shown to not be obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 2-11 for reasons given above with respect to Claim 1 (of which Claims 2-11 depend upon).

Further with respect to Claim 2, Applicants have amended such claim to include the feature of multiple selling sites, as described at Specification page 14, lines 14-17. None of the cited references teach or suggest such claimed feature, which advantageously allows for generation of a customized catalog from a plurality of different sources.

Further with respect to Claim 7, Applicants urge that none of the cited references teach or suggest the claimed feature of “wherein the step of establishing terms for purchasing an item from the customized catalog comprises presenting a set of default terms to the user; and negotiating a final set of terms from the set of default terms to form the terms for purchasing an item from the customized catalog”. Nor has the Examiner alleged any such teaching or suggestion. Thus, Claim 7 is further shown to have been erroneously rejected, as the Examiner has failed to properly establish a prima facie showing of obviousness.

With respect to Claim 12, such claim has been amended to include features from originally filed Claim 13. Applicants urge that none of the cited references teach or suggest the claimed method of generating a customized catalog, the method comprising: presenting a plurality of items to a user located at a second data processing system, placing an item from the plurality of items in a set in response to a selection of the item by the user, generating the customized catalog in response to a request indicating that the set is complete, and negotiating terms for purchasing items in the customized catalog. Because Barnes' catalog is not customized, but rather is a pre-existing catalog, there is no ability to negotiate terms for purchasing items in the catalog. Rather, an item is selected from the catalog and added to a requisition request, including inclusion of a pre-existing line item detail that is used to populate the requisition (Barnes col. 18, lines 42-44).

Applicants initially traverse the rejection of Claims 13-22 for reasons given above with respect to Claim 12 (of which Claims 13-22 depend upon).

Further with respect to Claim 13, such claim has been amended to include the feature of multiple sites having items included in the customized catalog, as described at Specification page 14, lines 14-17. None of the cited references teach or suggest such claimed feature, which advantageously allows for generation of a customized catalog from a plurality of different sources.

With respect to Claim 23, such claim recites a conglomeration of steps used to generate a customized catalog. Per MPEP 2106 (II)(C), when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."). Applicants urge that none of the cited references, either singularly or in combination, teach or suggest the claimed invention as a whole that is

recited in Claim 23. Thus, it is urged that Claim 23 is not obvious in view of the cited references.

Applicants traverse the rejection of Claim 24 for reasons given above with respect to Claim 23 (of which Claim 24 depends upon).

Applicants traverse the rejection of Claim 25 (and dependent Claims 26-35) for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 26 for similar reasons to the further reasons given above with respect to Claim 2.

Applicants further traverse the rejection of Claim 31 for similar reasons to the further reasons given above with respect to Claim 7.

Applicants traverse the rejection of Claim 36 (and dependent Claims 37-46) for similar reasons to those given above with respect to Claim 12.

Applicants further traverse the rejection of Claim 37 for similar reasons to the further reasons given above with respect to Claim 13.

Applicants traverse the rejection of Claim 47 (and dependent Claim 48) for similar reasons to those given above with respect to Claim 23.

Applicants traverse the rejection of Claim 49 (and dependent Claims 50-59) for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 55 for similar reasons to the further reasons given above with respect to Claim 7.

Applicants traverse the rejection of Claim 60 (and dependent Claims 61-70) for similar reasons to those given above with respect to Claim 12.

Applicants further traverse the rejection of Claim 61 for similar reasons to the further reasons given above with respect to Claim 13.

Applicants traverse the rejection of Claim 71 (and dependent Claim 72) for similar reasons to those given above with respect to Claim 23.

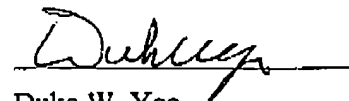
Therefore, the rejection of Claims 1-72 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 2/15/05

Respectfully submitted,



Duke W. Yee
Reg. No. 34,285
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants